

## REMARKS

Claims 1-44 and 46-48 are pending. Claims 1-7, 9-10, 12, and 42-47 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,721,784 B1 to Leonard et al. Claims 8, 11, 13-41, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leonard in view of U.S. Patent No. 6,078,921 to U.S. Patent No. 6,078,921 Kelley.

Reconsideration is requested. No new matter is added. Claims 1 and 13 are amended. Claim 51 is added. Claims 1-44, 46-48, and 51 remain in the case for consideration.

On the Office Action Summary page of the Office Action dated February 27, 2006, the Examiner indicated that claim 45 was withdrawn from consideration. The Applicant respectfully points out that claim 45, while canceled in response to the Office Action dated September 9, 2005, was in the elected group of claims, and so was not withdrawn from consideration.

The Applicant notes that the Examiner has indicated that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**" (*see* Office Action dated February 27, 2006, page 17; emphasis in original). The finality of this Office Action may be correct, but the Applicant respectfully submits that the Applicant's amendment did not necessitate new grounds of rejection: for example, independent claim 1 had not previously been amended, and independent claim 26 has yet to be amended. The Examiner has merely repeated the grounds for rejection from the Office Action dated September 9, 2006.

## REBUTTAL TO EXAMINER'S RESPONSE TO ARGUMENTS

In response to "Point A", the Examiner argues that Leonard teaches the limitations of the claims. The Examiner states that "applicant rightfully admits 'Leonard teaches: software with an origination component and a viewing component integrated together'" (*see* Office Action dated February 27, 2006, page 16). The Examiner appears to treat this as an admission that the features of the claims are taught, as the Examiner then says that "[t]his is a clear anticipation of the invention and the rejection . . . is maintained" (*Id.*).

The Applicant respectfully submits the Examiner misunderstood the Applicant's argument. The Applicant did indeed state that "Leonard teaches software with an origination component and a viewing component integrated together" (*see* Response to Office Action dated September 9, 2005, page 10). But the "origination component" is not the same as the message (i.e., "information to be displayed"). The origination component is software that is used to originate the message. Leonard makes this distinction. For example, Leonard recites that "it will be appreciated that any message

sent from the message origination software . . .” (see Leonard, column 15, lines 45-46). Leonard reinforces this point in the drawings: for example, in figure 7. It is also worth noting that in figures 9, 10, and 11, Leonard changes terminology: instead of referring to “message origination software”, Leonard refers to “message creation and sending software”. While linguistically this is a different term it should be apparent that “message origination software” and “message creation and sending software” are actually the same piece of software.

Figure 7 of Leonard further exemplifies the fact that the message and the viewer are not bundled together. In figure 7, the e-mail is sent from the sender to the recipient. But the viewer applet, if needed by the recipient, is retrieved from a central e-mail server, which is not along the same path as the message travels between the sender and recipient.

The Applicant’s statement that the origination component and the viewing component might be integrated is not the same as teaching information (e.g., a message) contained with the viewer in a single file. The Applicant’s statement was therefore not an admission that Leonard anticipates the claimed invention, but rather just a mere statement of fact about Leonard, which fact contradicts anticipation. Leonard fails to teach or suggest that the rich media file can include information and a viewer in a single file. Thus, claims 1, 42, and 46 are patentable under 35 U.S.C. § 102(e) over Leonard. Accordingly, claims 1, 42, and 46 are allowable, as are dependent claims 2-12, 43-45, and 47-48.

In response to “Point B”, the Examiner contends that Leonard teaches “‘building a message that includes only controls that are intended by the origination of the message’ is taught by Leonard” (see Office Action dated February 27, 2006, page 16). The Examiner cited to column 23, lines 55-61 of Leonard in support of this assertion.

The Applicant respectfully submits that the Examiner again misunderstood the Applicant’s argument. First, claim 12 recites a “viewer includ[ing] only a capability desired by a builder of the rich media file”. Thus, in claim 12, it is the viewer capabilities that are included or not, not message features.

Second, as claim 12 recites a “viewer includ[ing] only a capability desired by a builder of the rich media file”, by implication, the viewer omits any capabilities the builder does not desire. The motivation to omit capabilities not desired is to keep the viewer size small, which in turn reduces the amount of time needed to receive the rich media file (which includes the viewer). In contrast, Leonard only describes the “MCS records . . . as a basis for varying the controls or limitations placed on a message” (see Leonard, column 23, lines 55-56). By including the MCS record in the message,

Leonard provides greater flexibility for the sender of the message – the sender can enable or disable particular features in the viewer. But the viewer applet always includes all capabilities: the MCS record simply controls whether those features are available to the recipient of the message. Thus, Leonard does not teach or suggest a “viewer includ[ing] only a capability desired by a builder of the rich media file”. Claim 12 is therefore patentable under 35 U.S.C. § 102(e) over Leonard, and is therefore allowable.

In response to “Point C” and “Point D”, the Examiner merely refers to the rejections of claims 13 and 14: the Examiner has therefore not specifically responded to the Applicant’s arguments. According to MPEP § 707.07(f), “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it”. As the Examiner has merely referred to the statement of rejection, the Examiner has not answered the substance of the Applicant’s arguments.

#### REJECTIONS UNDER 35 U.S.C. § 102(e)

Claim 1 is directed toward a rich media file stored in a machine-readable medium, comprising: information to be displayed on a computer system, the information including text and at least one image; and a viewer designed to display the information on the computer system, the information and the viewer contained in a single file.

Claim 42 is directed toward a memory for storing a platform-independent rich media file including a data structure stored in said memory, comprising: information for the rich media file; a unique identification for the rich media file; a version number for the rich media file; a viewer for displaying the information; and at least one viewing option for the rich media file.

Claim 46 is directed toward a memory for storing a database of rich media files including a data structure stored in said memory, comprising: a rich media file, the rich media file including information and a viewer to view the information; a profile of a user who downloaded the rich media file; a client who generated the rich media file; and a log storing a transaction in the data structure.

Claims 1, 42, and 46 of the application all include information to be displayed on a computer screen and a viewer to display the information, with both these components built into a single file.

In contrast, Leonard teaches a system and method for enabling the originator of an electronic mail message to preset an expiration time, date, and/or event, and to control and track processing or handling by all recipients. Leonard uses message origination software to create an email message, and FIGs. 1 and 6-8 show that the message origination software can be integrated with a viewer

applet to view the message. By integrating the message origination software with the viewer applet, Leonard allows users to enable and disable message controls and features for viewing the message.

Leonard teaches integrating the origination software with the viewer applet in column 18, lines 53-55 saying, “the viewer and origination software are combined into a single program.” Although Leonard teaches software with an origination component and a viewing component integrated together, Leonard does not teach a viewer applet contained with the message itself in a single file as recited in claim 1. Indeed, column 14, lines 51-55 describes “retaining the message on the electronic mail server and requiring the recipient to view the message using the viewer applet”. Later in column 14, lines 60-63, Leonard says that the viewer applet retains only “transient storage of the message. Since the message exists only on server 1...” This reference to transient storage of the message should make it clear that the applet is not part of the message itself. Rather, Leonard is clear in that a message is not transmitted to the user with the viewer applet, but instead the viewer applet is used to allow the viewer to view the message that is stored on the electronic mail server.

In arguing that Leonard teaches the message and viewer applet as a single file, the Examiner has cited to column 9, lines 28-30, where Leonard teaches “a simple viewer applet that can be distributed to the recipient with the message whose lifespan is to be controlled.” Even though Leonard teaches a viewer applet distributed with a message, he still does not teach that the viewer applet and the message are contained in a single file as claimed. Indeed, Leonard suggests otherwise in column 15, lines 13-16, where Leonard teaches that to forward a message, a recipient must first download a viewer applet if necessary, and then the message is transmitted to the installed viewer applet. The fact that Leonard teaches that a viewer applet can be already be downloaded on a recipient’s computer shows that the message is in fact not stored in or with the viewer applet itself. If the message were stored on the applet, then it would not make sense for Leonard teach that a user can reuse a previously downloaded viewer applet, when a new message is forwarded to a recipient.

Thus, it should be clear that Leonard fails to teach, and in fact even teaches away from, combining the viewer applet with the message itself in a single file. Because Leonard does not teach or suggest this feature, claims 1, 42 and 46 are not anticipated by Leonard. Thus, claims 1, 42, and 46 are patentable under 35 U.S.C. § 102(e). Accordingly, claims 1, 42, and 46, as well as dependent claims 2-12, 42-44, 47, and 48 are allowable.

Claim 12 is directed toward a rich media file according to claim 1, wherein the viewer includes only a capability desired by a builder of the rich media file.

As described in the specification on page 6, lines 1-11, viewing options are built into modules that may be included or excluded from the rich media file depending on the preference of the creator of the rich media file. By allowing the inclusion or exclusion of modular components, the creator is able to create a rich media file that has no unnecessary overhead. For example, a rich media file creator could desire that users viewing the file be allowed to print the file while viewing the file and include the printing module in the build of the rich media file. By including the printing module, the rich media file will have to include the printing module, and will thus have the overhead of the printing module included. Another file creator could instead prefer that users not be able to print the rich media file, and thus would exclude the printing module from the rich media file. By excluding the printing module, the storage that would be required to include in the rich media file will not be necessary, and therefore the file can be smaller. By including only the desired features, the rich media file is able to stay as small as possible, making it easier to transmit over networks.

Leonard does not teach building a message that includes only controls that are intended by the originator of the message. Instead, Leonard teaches control by providing disablement of undesired features. In column 16, lines 12-26, Leonard teaches "in the message header, as mentioned above, are fields for including control information used to enable or disable electronic mail processing or handling functions...." By allowing features to be disabled by setting a field in a file header, Leonard makes clear that the viewer applet includes all features; the message sender can choose to disable certain features, but not remove them from the viewer applet. Thus, the viewer applet does not include "only a capability desired by the builder of the rich media file".

By teaching a system where control of features that are to be included in the message resides in a header for the message, Leonard does not teach building a rich media file, where some control components are included or excluded based on the intent of the creator. While this approach does provide for flexibility in creating and managing messages, Leonard's approach does not address the additional issue of creating a file that is only as large as it must be to provide the desired features.

Because Leonard fails to teach a viewer including only a capability desired by a builder of a rich media file, claim 12 is not anticipated by Leonard. Therefore, claim 12 is patentable under 35 U.S.C. § 102(e), and claim 12 is allowable.

#### REJECTIONS UNDER 35 U.S.C. § 103(a)

Claim 13 is directed toward a rich media file stored in a machine-readable medium, comprising: information to be displayed on a computer system, the information including an image and compressed using a compression technique; a viewer designed to display the information on the

computer system; limit means for limiting viewing of the rich media file, the limit means drawn from a setting defining a predetermined number of viewings of the information, a setting defining a predetermined number of days, a predetermined expiration date, and a password controlling access to the rich media file; checking means for checking if there is a later version of the rich media file; a query asking a user if the user would like to retrieve the later version of the rich media file; retrieval means for retrieving the later version of the rich media file; and a unique file identification for the rich media file in addition to a file name.

Claim 14 is directed toward a method for retrieving a rich media file, the method comprising: selecting a link on a network; downloading the rich media file over the network based on a unique file identification other than the link and other than a file name, the rich media file including a viewer and information to be displayed in the viewer; and saving the rich media file on a computer system.

Claim 26 is directed toward a method for building a unitary rich media file, the method comprising: assembling information for the unitary rich media file; formatting the information; coupling the information with a viewer; and converting the information and the viewer to the unitary rich media file, so that the unitary rich media file is designed to leave no footprint on a user's system when removed.

As with the independent claims discussed above with reference to the 35 U.S.C. § 102(e) rejection, claims 13, 14, and 26 are also directed to a rich media file including a rich media file viewer along with information to be displayed by the viewer. As previously discussed above, rather than teaching this feature of the present application, Leonard actually teaches away from this feature.

The Examiner has not cited to Kelley as teaching this feature, and the Applicant believes that Kelley in fact does not teach this feature. Kelley teaches a method and apparatus for providing a self-service file. Kelley does not teach or suggest a special viewer for the self-service file, but instead, as in column 7, lines 53-54, Kelley teaches a "browser application or any other multi-part file viewer."

Furthermore, claim 13 includes a unique file identification for the rich media file in addition to a file name, and claim 14 downloads a file based on a unique file identification other than the link and other than a file name. While Leonard might suggest a unique file identification by teaching message attributes included in a header, Leonard does not provide a single unique file identification for a rich media file that guarantees a unique identifier other than a file name. According to column 10, lines 63-66, attributes that are provided by Leonard can include the date the message is created, time the message is sent, the sender, and a title or name of the message. Even in combination, these attributes do not necessarily uniquely identify a message: for example, a single message that is copied to multiple people

would share all the same attributes, but the copies going to different recipients are different messages. Thus, it is misleading to call these attributes a unique message identifier.

Finally, Leonard is concerned with the creation of email messages, and does not teach or suggest creating links to rich text files. The Examiner cites to Kelley as teaching the feature of downloading a rich media file over a network based on a unique file identification other than the link and other than a file name. In column 8, lines 24-64, Kelley teaches downloading a file over a link. However, Kelley does not teach accomplishing this by using a unique file identification other than the link or name of the file. In fact, Kelley does not even teach a unique file identification different from a file name.

As neither Leonard nor Kelley teach a unique file identification in addition to a file name, particularly a unique file identification that is used in downloading a file over the network, these features of claims 13 and 14 are not or suggested by Leonard or Kelley. Further, neither reference teaches or suggests combining the compressed information with the viewer into a single file as included in claims 13, 14, and 26. Thus claims 13, 14 and 26 are patentable under 35 U.S.C. § 103(a). Accordingly, claims 13, 14, and 26 are allowable, as are dependent claims 15-25, 27-41, and 51.

Claim 29 is directed to a method according to claim 26, wherein formatting the information includes selecting viewing options to include with the rich media file.

As previously discussed this allows the creator of the rich media file flexibility in creating a file having only the file overhead required to support the desired capabilities, while excluding overhead for undesired features.

As discussed above, Leonard does not teach or suggest building a rich media file with only the desired capabilities, but instead teaches that undesired capabilities can be disabled as reflected in a header. While disablement might be useful in that it prevents the recipient of the rich media file from using the file in a way undesirable to the creator, disablement still includes overhead in the file that the present application is directed to avoid.

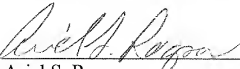
Similarly, Kelley also fails to teach or suggest that only desired capabilities or viewing options are built into a rich media file. Kelley teaches a method and apparatus for providing a self-service file. The Examiner has not cited to Kelley as teaching or suggesting this feature. Furthermore, the Applicant does not believe that Kelley teaches or suggests this feature.

Because neither Leonard nor Kelley teach or suggest building a rich media file with only desired capabilities or viewing options, claim 29 is patentable under 35 U.S.C. § 103(a). Accordingly claim 29 is allowable.

For the foregoing reasons, reconsideration and allowance of claims 1-44, 46-48, and 51 of the application as amended is solicited. **The Applicant requests that the Examiner telephone the undersigned at (503) 222-3613 to schedule an interview.**

Respectfully submitted,

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